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Supreme Court of the United States

October Term, 1963
No. 361

ENGELHARD INDUSTRIES, INC.,
Petitioner,

vs.

RESEARCH INSTRUMENTAL CORPORATION,
Respondent.

Reply Brief of Petitioner for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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IN THE

Supreme Court of the United States

October Term, 1963

No. 861

ENGELHARD INDUSTRIES, INC.,

Petitioner,

vs.

RESEARCH INSTRUMENTAL CORPORATION,

Respondent.

Reply Brief of Petitioner for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

I.

The Exercise of This Court's Certiorari Jurisdiction Is Requested for Cogent Reasons.

Petitioner asserts and respondent *does not deny* that the *sworn testimony of record* (Pet. Br. p. 10; R. 22-R. 25; R. 32, R. 83-R. 86) creates a genuine issue of material fact. Instead, respondent asserts that petitioner was and is now estopped from pointing out the specific portions of the record creating genuine issues of material facts allegedly because petitioner has not precisely conformed with the technicalities of the adjective law involved (Resp. Br. p. 21).

However, the sworn testimony in question was part of the record relied upon by the respondent in its mo-

tion for summary judgment [R. 90, item 2]. This record was also a part of the record on appeal and forms a part of the record before this Court.

A most important question, therefore, is whether or not the entire record, as specifically provided in Federal Rules of Civil Procedure 56(c) must be considered, or is it a fatal error to the party responding to a motion for summary judgment if it does not point out with particularity those portions of the record creating a genuine issue of material fact, *even though such portions of the record are a part of the moving party's own documents.* In other words, is Rule 56(c) of the Federal Rules of Civil Procedure to be interpreted on the basis of the manner in which counsel may identify portions of the sworn testimony creating a genuine issue of material fact, or more properly is the test to be whether or not such sworn testimony does in actuality create a genuine issue of material fact. Rule 56(c) of the Federal Rules of Civil Procedure provides that judgment shall be rendered forthwith if the sworn testimony, *including admissions*, shows that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment *as a matter of law*" (emphasis added).

Equally important, is the fact that although a part of the record clearly showing a genuine issue of material fact (in the form of denials to requests for admissions [R. 22-R. 25, R. 32, R. 83-R. 86]) was before the Court of Appeals, it refused on a request for rehearing to consider such record (Pet. Br. App. C. pp. 36-37) and *further refused* to permit the then appellant to supplement the record with other portions of the discovery proceedings (Pet. Br. App. C. p. 39)

showing a genuine issue of material fact and relating to the *new* factual issue upon which the Court of Appeals *sua sponte* affirmed summary judgment. Such further documents were included in the respondent's own motion [R. 90-R. 93] but not included as part of the appeal record because of the limited issue of file wrapper estoppel.

These questions are extremely important as a matter of public interest since the present decision, as it now stands, overlooks the principles so clearly ennunciated by this Court in the case of *Conley v. Gibson*, 78 S. Ct. 99, 355 U. S. 41, 2 L. Ed. 2d 80. (Pet. Br. p. 17) pointing out that the Federal Rules are to facilitate a proper decision on the merits and are not meant to have one misstep of counsel be decisive to the outcome.

II.

The Record Upon Which the Motion Was Granted.

The questions heretofore presented, of course, must be further weighed on the basis of the testimony offered on behalf of the moving party in substantiating the motion. This testimony consists of an affidavit of the moving party's attorney, presumably relating to matters of personal knowledge, but correlating such alleged personal knowledge with claim language to in effect and in fact reach a conclusion of law on the ultimate question of infringement. Other than this affidavit of counsel, the only other pertinent part of the record substantiating the respondent's position is an ambiguous admission which is clearly negated by some *thirteen* denials [R. 22-R. 25, R. 32, R. 83-R. 86]. The *ambiguity* of this admission is considered in detail in petitioner's request for rehearing before the Court of Appeals (Pet. Br. App. C. pp. 37-38).

Upon the issue of file wrapper estoppel (to which the appeal was directed), such record was possibly sufficient since the arguments of record in the file wrapper are deemed to define the critical terms used. However, in consideration of the issue of infringement, the very words used in the claims are extremely critical and determinative of the final conclusion of law, and therefore the entire record must be considered in ascertaining the meaning of and relating the words used in the affidavits to the terminology employed in the claims of the patent and vice versa. Thus, it is submitted that the reviewing Court erred in not considering other portions of the record before it and in not permitting the then appellant to supplement the record with other portions of the extensive discovery proceedings included in the *respondent's own* motion documents [R. 90-R. 93] and creating genuine issues of material fact as to the facts determinative of the issue of infringement.

(Furthermore, it is believed the error was compounded in the trial court when it refused to grant a rehearing on the basis of the new evidence in the form of the admissions against interest contained in Patent No. 2,992,170 issued to respondent after the motion hearing (Pet. Br. App. C., p. 39).)[1]

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[1]Although the Court of Appeals took note of Patent No. 2,992,170 (Pet. Br. App. B, p. 28, note 5), it thought the patent had issued prior to the hearing rather than after the hearing; and it further did not appreciate the nature of the admissions against interest (Pet. Br. App. C, p. 38).

III.

Respondent Has Relied Upon Adjective Law as a Basis for Supporting a Decision Inconsistent With the Merits of the Issues Involved.

Respondent emphasizes and re-emphasizes the fact that petitioner filed untimely affidavits (Resp. Br. pp. 2, 9, 10, 11, 14); however, respondent does not recognize that in summary judgment proceedings the Court must not only consider affidavits, but also the sworn testimony of record to see whether or not a genuine issue of material fact exists (F. R. C. P. 56(c)). The respondent further argues that petitioner is estopped from pointing out portions of the record not heretofore specifically designated, citing the case of *Watson v. Button* (C. A. 9th, 1956), 235 F. 2d 235; but that case only stands for the proposition that the court will not render a decision on a point wherein "the complete record on this point is not before us". In the instant case, the record is before the Court, and was before the Court of Appeals. *Furthermore,* the very essence of a part of the alleged error of the Court of Appeals relates to rendering a decision on an ultimate factual issue in a summary judgment proceeding *based solely on a minute portion of the record relating to a different legal issue involving different fact questions without giving petitioner an opportunity to supplement the record in this regard.*

Insofar as the *Dulansky* opinion (*Dulansky v. Iowa-Illinois Gas & Electric Co.* (U. S. D. C. S. D. Iowa, 1950), 10 F. R. D. 566)), is concerned, it is noted, as respondent has stated, that this decision was reversed. Furthermore, the decision was reversed without any specification or errors, the Court merely point-

ing out that there was not sufficient evidence to justify the holding that no genuine issue of material fact in fact existed. Also, it is to be noted that respondent's quoted portion of the opinion is followed by:

> "For this reason, the Court has scrutinized the record to determine whether any facts exist in support of any denied requests appearing in the discovery procedure."

Thus, even this lower court recognized that the full record must be examined if denials to requests for admissions rebutt the evidence offered on behalf of the moving party in support of its motion for summary judgment.

IV.
Conclusion.

In view of the foregoing, it is respectfully urged that the record before this Court is more than sufficient to warrant the exercise of this Court's certiorari jurisdiction. It is, therefore, believed clear that the Petition should be granted.

Dated: April 27, 1964

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